UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC DAVID BLOCH, JEFFREY EVAN BEALL, GORDON ANSON DURAND, and RALPH D. HILL

Appeal No. 2005-2523
Application No. 09/441,729

ON BRIEF

Before HAIRSTON, BARRETT and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19. For the reasons stated *infra* we affirm the examiner's rejection.

THE INVENTION

Appellants' invention relates to a software architecture and control protocol that enables seamless playback of multiple clips of media data across a data network, see page 4 of appellants' specification

Claim 1 is illustrative of the claimed invention, and reads as follows:

1. A method of playing media data stored over a data network comprising the steps of:

accessing a playlist wherein said playlist specifies a first clip and a second clip to be played and wherein said first clip is stored within a first source and said second clip is stored within a second source;

translating said playlist into a first plurality of frame accurate requests that specify first respective frames of said first clip and a second plurality of frame accurate requests that specify second respective frames of said second clip;

transmitting said first plurality of frame accurate requests over said data network to said first source; transmitting said second plurality of frame accurate requests over said data network to said second source;

receiving said first respective frames from said first source;

rendering said first respective frames at a predetermined framerate;

before a last frame of said first respective frames is rendered, receiving a first frame of said second respective frames from said second source;

rendering said first frame of said second respective frames after said last frame at said predetermined framerate such that playback of said first clip and said second clip appears seamless.

REFERENCES

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

DuLac et al (DuLac)	5,790,794	Aug. 4, 1998 (filed Aug 11, 1995)
Langford et al (Langford)	5,206,929	Apr. 27, 1993

REJECTION AT ISSUE

Claims 1 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Langford in view of DuLac. The examiner's rejection is set forth on pages 4 through 8 of the Final Office Action, dated April 7, 2004.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs, along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and examiner, for the reasons stated *infra*, we will sustain the examiner's rejection of 1 through 19 under 35 U.S.C. § 103.

At the outset, we note that appellants state on page 6 of the brief: "[a]ppellant submits that claims 1-19 fall into two groups: Group 1 includes claims 1, 3-6, 14 and 16-19; and Group II includes claims 2, 7-13, and 15. Claim Groups I and II do not stand or fall together for at least the reasons presented below and for other reasons presented in the Arguments section."

Accordingly, we group claims 1, 3-6, 14 and 16-19 and will consider claim 1 as a representative claim of that group, and we will group claims 2, 7-13, and 15 and consider claim 7 as representative of that group.

Rejection of claims 1, 3-6, 14 and 16-19

Appellants argue on page 10 of the brief: "the subject matter of claims 1, 3-6, 14 and 16-19 may be suitable for implementation in a "client pull" manner. Applicants submit that for various reasons the Langford reference and the DuLac reference do not teach or suggest the subject matter of claims 1, 3-6, 15 and 16-19."

We are not convinced by this argument. While the claimed invention may be suitable for implementation in a "client pull" manner, we find no claim limitation in claim 1 directed to implementation in a client pull manner.

Appellants state, on page 11 of the brief, that Langford is directed to an offline video editing system, which relies upon a video switcher to select video signals from a bank of video tape or laser disk players. Appellants argue on pages 11 and 12:

> Thus, the Langford reference contemplates providing a video signal from the bank of video tape or laser disk players 50 directly to the monitor 35. Note that the Langford reference does not disclose, teach or suggest that the workstation 30 be included in this display loop. Consequently, the Office erred when it stated that Langford reference discloses or teaches a "workstation for receiving video clips." Instead, the Langford reference discloses and teaches a monitor to display a video signal from a video tape or disk player. The Langford reference simply does not teach playing media data stored over a data network – it teaches operation of a video tape or video disk player to send a video signal to a video monitor.

In response, on pages 4 and 5 of the answer, the examiner states:

> [T]he examiner refers to Figure 9 of Langford, which as discussed above, teaches the graphical user interface of the edit control software. In addition to video editing controls, windows (140-145) are displayed on the user interface of the edit computer. Each window displays the frames of video from the various sources (Col. 9, lines 48-52). Langford clearly teaches that the workstation is included in the display loop due to the fact that the video signals are provided to the workstation (edit controller 30) in order to be displayed on the graphical user

> interface. Referring to Figure 2, the only path from video source (50) to monitor (35) is through the edit controller (30). This precludes the possibility of providing video directly to the monitor without including the workstation in the loop. Further, the examiner points out that the Appellant [sic, appellants] have not claimed the argued "display loop."

Further, In response to appellants' assertion that Langford does not teach playing media data stored over a network, the examiner argues that DuLac teaches playing media data stored over a network and that the claims are rejected over the combination of the references.

We find the examiner's reasoning to be persuasive. We concur with the examiner's findings that the embodiment of Langford, in figure 9, teaches that the video data goes to the edit controller and thus the edit controller is in a display loop. We concur that claim 1 does not include a limitation directed to a display loop; rather, claim 1 is silent as to whether the frames from the first or second source are received over the same data network on which the frame accurate requests are transmitted. We also concur with the examiner's findings that DuLac teaches distributing video data over a network.

Additionally, it appears from appellants' arguments that appellants disagree with the examiner's findings that the video signal, from the laser disk players, meets the claimed "media data." It is apparent from the examiner's statements on page 4 of the Final Office Action, that the examiner is considering the video signal output of the video sources, items 50, to be media data.

In analyzing the scope of the claim, office personnel must rely on the appellants' disclosure to properly determine the meaning of the terms used in the claims. ***Markman v. Westview Instruments, Inc.***, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original) ***In re Cruciferous Sprout Litigation,*** 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing ***Intervet America Inc v. Kee-Vet Laboratories Inc.*** 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). Appellants have not provided a definition of claim term "media data." Further, appellants' specification does not define the term, but rather describes media data as consisting of frames that are rendered and provides examples of media data. See page 4 of appellants' specification. See also pages 10 and 11 of appellants' specification, which states "[t]he present invention is directed to a system and method for enabling a user to view media data (e.g. movie data, video data, audio data, meta data, etc.) using a workstation connected to a digital network." Thus, we consider the scope of the term "media data" to be data that presents frames of information to be viewed as images. Langford teaches that video signals contain frames of information to be viewed as images. See column 1, lines 40-45. Thus, we find that Langford's video signal from video sources, items 50, meets the claimed "media data."

Appellants argue, on page 12 of the brief:

> [T]he Langford reference does not disclose a single rendering capability for the workstation 30. Instead, the Langford reference discloses and teaches

> rendering at the video tape or video disk player, i.e. the "source" identified by the Office. In contrast, the Langford reference identifies the tape or video disk as the source (col. 13, line 9), not the player 50, transmitting requests to a tape or disk makes little sense. Consequently, the transmitting, receiving and rendering of claims 1, 3-6, 14 and 16-19 are not taught or suggested by the Langford reference because the Langford reference is concerned with video signals and not media data stored over a data network.

In response, the examiner states, on pages 5 and 6 of the answer, that the term rendering is interpreted to have the standard meaning of "[t]o convert (Graphics) from a file into a visual form, as on a video display." Further, the examiner asserts:

> Langford clearly teaches displaying the stored video data on a computer screen as shown in Figure 9. Further, Langford discloses that the video data may be stored on a magnetic disk drive as stated above. Therefore, the act of communicating video data stored on a disk drive (50) for display on a computer (30) monitor (35) in a window (140-145) of a graphical user interface clearly reads on the claimed rendering.

In rebuttal, appellants assert, on page 3 of the reply brief, even assuming Langford is referring to laser video disk players as random access memory units, "[t]his evidence does not alter the fact that the 'random access memory units' produce video signals, nor does it suggest that the off-line edit controller 30 can now receive media data over a data network and render such media data." Further, appellants assert that Langford's discussion of using other random access memory units, such as magnetic disk drives, does not suggest that the other devices transmit media data to the off-line edit controller. Appellants conclude that "[t]he Examiner's Answer is in error because it ignores that these units are 'players', it seeks to shift the 'player' functions to the off-line

edit controller and it aims to create a data network for transmission of media data where none exists." Additionally, on page 4 of the reply brief, appellants take exception to the examiner's interpretation of the term "rendering", without proffering an alternative; rather, appellants' arguments focus on the random access memory units providing video signals and not media data.

We concur with the examiner's claim interpretation of the term "rendering" and find that the examiner's findings regarding Langford are reasonable and supported by evidence of record. The examiner interprets the term rendering as, to convert graphics files into a visual form. Neither appellants' arguments nor appellants' specification provides an alternative definition, and the examiner's interpretation is consistent with appellants' specification. Further, as noted *supra*, though appellants' arguments refer to video data and media data as separate types of data, appellants have identified no distinction between the two. As stated *supra, we* find that the video signal meets the claimed media data. Further, appellants' assertion that Langford's players 50 perform the rendering of the video data is not well taken as neither the data stored on the disk nor the data in the form of video signal, is rendered, presented visually, at the player. Rather, we find that Langford teaches that the video data is presented visually to the user and hence rendered, either on one of a plurality of monitors or, in the embodiment applied against the claims by the examiner, on the off-line editor's Graphical User Interface shown in figure 9.

On page 13 of the brief, appellants assert that there is insufficient evidence in DuLac or Langford to suggest to one of ordinary skill in the art to combine the respective teachings of the references. On page 13 of the brief, appellants assert that DuLac is concerned with Video-On-Demand (VOD) systems and as such provides no motivation to modify the Langford reference. Further, appellants assert that since Langford is related to edit controls for video and DuLac is related to VOD the examiner has presented insufficient evidence of a reasonable expectation of success in combining the references.

The examiner responds on page 6 of the answer:

> The examiner points out that Langford discloses the use of video signals from a magnetic disk drive remote from the processor as stated above and DuLac discloses the use of video signals on a client from a remote server as stated above. The video storage of Langford (50) is remote from the edit controller computer (30) and connected via bi-directional connection such that commands may be transmitted from the controller and data received. As stated above, DuLac is concerned with the storage and playback of video data over a network between a client and server. In terms of Langford, the client is the edit controller (30) and the server, that is, the video source, is the remote disk drive (50). In combination, the communication network (56) of DuLac would simply be the transmission line between the edit controller and remote disk drive of Langford as shown in figure 9.

Further, on page 7 of the answer, the examiner states:

> It would have been obvious to one having ordinary skill in the art at the time of the invention was created that Langford and DuLac both teach a client retrieving video data from a remote storage device over a transmission line, and as such, the references are analogous art. Further, as was well known at the time of invention, utilizing a video server to service multiple clients, as demonstrated by DuLac, is highly advantageous as it allows a single, scalable system to supply data to multiple clients as opposed to requiring each client to have massive, costly, and subsequently redundant storage locally.

On page 7 of the answer, the examiner addresses appellants' argument that the rejection has not shown a reasonable expectation of success since Langford is concerned with VOD by stating:

> The invention of DuLac is not constrained to any particular embodiment such as video on demand, although it may be used in such an environment. Referring again to the figure 2 of Langford, it can be seen how a remote disk (50) is connected to a workstation (30). Referring to Figure 2 of DuLac, it can be seen how a remote video server (52) is connected to a workstation (54) through a network (56). In combination, the network (56) of DuLac would simply by [sic, be] interposed between Langford's disk (50) and workstation (30). As both invention deal with the transmission of video from a remote storage device to a workstation, the art is highly analogous, and as a result, combination is proper.

Appellants rebut the examiners arguments, on page 4 of the reply brief, arguing that the office action, in substituting DuLac's communications network for the transmission line between the edit controller and remote disk drive of Langford, "fails to consider that the Langford reference teaches that the so-called 'remote disk drive' is [a] substitute for the storage component of the 'laser video disk player', i.e., a storage component of another 'random access memory unit', where the 'unit' is a player [that] transmits a video signal to an off-line edit controller." Additionally, on page 5 of the reply brief, appellants argue:

> [T]here is no evidence in the Langford reference to suggest that the "magnetic disk drives" transmit digitized video data to the off-line edit controller. The Langford references (col. 16, lines 28-29) states "[f]or example , the takes may be digitized and stored in magnetic disk drives." It does not suggest that these drives are somehow connected to the off-line edit controller to send media data over a data network. Appellant submits that the "magnetic disk drives" function as a storage as would a "laser video disk drive", which is a component to a "laser video disk player."

We find that the examiner has established a ***prima facie*** case of obviousness and that the appellants have not rebutted that ***prima face*** case of obviousness. Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker,*** 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. ***In re Sernaker,*** 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." ***In re Huston,*** 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002) (citing ***In re Kotzab,*** 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)). We find, as the examiner states, that both Langford and DuLac are concerned with transmitting video data. As stated by the examiner, DuLac teaches a system to improve performance of storing and playing videos over a communications network. See column 2, lines 53-63. Further, while DuLac discusses the use of the communications network in conjunction with VOD, it also identifies that broadband network communications for video can also be used with video editing, interactive games and home shopping. See column 1, lines 24-31. Thus, we find ample evidence of record to support the examiner's findings that one of ordinary skill in the art would

have been led to combine the references.

We do not find appellants' arguments persuasive to rebut the examiner's ***prima facie*** case of obviousness. Contrary to appellants' arguments the claims do not include a limitation of transmitting a "digitized video data." We are not persuaded by appellants' arguments directed to Langford's magnetic disk drive functioning as would a laser disk player. Appellants' arguments appear to be distinguishing video signals from media data and the claimed source from the video players, however, we find no distinction. As stated *supra* we consider Langford's video signal to meet the claimed media data. Further, as stated *supra* we do not find that the rendering step differentiates Langford's players (50) from the claimed source as we consider the rendering step to be occurring at the graphical user interface shown in figure 9. Accordingly, we sustain the examiner's rejection of claims 1, 3-6, 14 and 16-19 under 35 U.S.C. § 103.

Rejection of claims 2, 7-13 and 15

Appellants assert on page 14 of the brief that the claims in this group require the first and second servers to receive frame accurate requests and provide the frames to the client computer for rendering. Appellants argue, on page 14 of the brief, "The reasons set forth above for errors by the Office and patentability of claims 1, 3-6, 14 and 16-19 also apply to claims 2, 7-13, and 15. Applicant submits that for various reasons the Langford reference and the DuLac reference do not teach or suggest the subject matter of claims 2, 7-13 and 15." On page 15 of the brief, appellants argue that

Langford does not teach a server. Additionally appellants present arguments that there is insufficient motivation to combine, as DuLac is directed to VOD, and there is insufficient evidence as to a reasonable expectation of success.

We are not convinced by appellants' arguments. As stated *supra* we are not convinced by appellants' arguments directed to the examiner's rejection of claims 1, 3-6, 14 and 16-19. We concur with the examiner's findings, on page 8 of the answer, that DuLac teaches the use of servers for transmitting video data. See column 3, lines 37-44 and column 4, lines 20-21. As stated *supra* we find ample suggestion to combine the references as asserted by the examiner. Accordingly, we sustain the examiner's rejection of claims 2, 7-13 and 15 under 35 U.S.C. § 103.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in ***In re Berger,*** 279 F3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellants did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. ***See also In re Watts,*** 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

CONCLUSION

In summary we sustain the examiner's rejection of claims 1 through 19 under 35 U.S.C. § 103. The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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